

ELECTION

Applicants elect Claims 1-3 of Group I, with traverse as follows. Applicants respectfully point out to the Examiner that MPEP 1850 states the following, in relevant part:

"[I]t is clear that the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Examining Authority. However, the International Searching Authority or the International Preliminary Examining Authority should not raise objection of lack of unity of invention merely because the inventions claimed are classified in separate classification groups or merely for the purpose of restricting the international search to certain classification groups."

In this regard, applicants respectfully note that the International Preliminary Examination Report (IPER) does not contain an indication of "lack of unity of invention" between the claims of the underlying PCT application which were substantially similar to the claims presently pending in this application, both product claims and method of making claims. Applicants submit that the U.S. Examiner should adhere to the examination decision of the International Preliminary Examining Authority and not assert lack of unity of invention under PCT Rule 13.1 during the U.S. national phase.

Applicants further submit that the claims of Group I and the claims of Group II possess "unity of invention" because they share a special technical feature as required by PCT Rule 13.2. PCT Rule 13.2 states the following, in relevant part:

"[T]he requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression 'special technical features' shall mean

those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."

In the present application, the special technical feature that is shared between Group I, the product, and Group II, the method of manufacturing the product, is the "ciclesonide-containing sterile aqueous suspension" comprising "sterilization by autoclaving". Applicants respectfully point out that these two features together comprise a special technical feature shared by all of the claims contained in Group I and Group II. Moreover, Applicants submit that the specifically recited special technical feature is not found in the prior art.

Accordingly, the claims of Groups I and II all possess unity of invention because (1) the International Preliminary Examining Authority did not find a lack of unity of invention under PCT Rule 13.1, and (2) all claims share the special technical feature of a "ciclesonide-containing sterile aqueous suspension" comprising "sterilization by autoclaving". The Examiner is therefore respectfully requested to reconsider and withdraw the restriction / election requirement of claims 1-9.

CONCLUSION

Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and withdraw the restriction / election requirement of pending claims 1-9.

The Examiner is welcomed to telephone the undersigned attorney if she has any questions or comments.

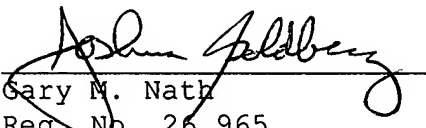
If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,

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